

REMARKS

Claims 1, 2, 4-6, 8, 11, 13, 14, and 16 are pending in the application. By this Amendment, claims 3, 7, 9, 10, 12, and 15 are cancelled without prejudice or disclaimer. Claim 1 is amended to include the subject matter of cancelled claim 3. Thus, no new matter is added.

Interview

A personal interview was conducted on September 16, 2008 between Applicants' representative and Examiner Marchaeschi. During the interview, the subject matter of the application was first discussed by describing the semi-conductor polishing composition that polishes a semi-conductor at a high speed due to the particle size and dispersion characteristics of fumed silica particles. A specific discussion ensued regarding the particular diameters occurring in the polishing composition in the amounts recited in the claims and the outstanding rejection of the claims as the rejection pertained to the size distribution of the particles disclosed in the applied reference. Proposed amendments were also discussed specifically regarding an amendment to independent claim 1 to include the subject matter of dependent claim 3. During the interview, the Examiner agreed that such an amendment would likely overcome the applied references of record. As independent claim 1 is so amended, we submit that all of the pending claims are in condition for allowance.

Claim Rejections – 35 U.S.C. §102/103

Claims 1-16 are rejected under 35 U.S.C. §102(a) as being anticipated by US Patent Application Publication 2004/0159050 to Pasqualoni, et al. (Pasqualoni), or under 35 U.S.C. §103(a) as obvious over Pasqualoni. As claims 3, 7, 9, 10, 12 and 15

are cancelled, the rejection of those claims is moot. The rejection of claims 1, 2, 4-6, 8, 11, 13, 14 and 16 is respectfully traversed.

As discussed and agreed during the interview, Pasqualoni fails to disclose or suggest all of the features recited in the rejected claims. For example, Pasqualoni fails to disclose or suggest, a semiconductor polishing composition...wherein the number of particles of fumed silica having a particle diameter of 0.5 μm or more is 600,000 pieces/ml or less and the number of particles of fumed silica having a particle diameter of 1 μm or more is in a range of 500 to 6000 pieces/ml, as recited in independent claim 1 as amended.

It is admitted in the Office Action that although “the reference does not explicitly teach the number of particles in the 1 micron size range, it does teach the number of particle[s] in the 0.5 micron range and since the number of particles will display a size distribution, it is viewed as apparent that the size distribution of the reference reads directly on the size distribution of the claimed invention absent any evidence to the contrary, which applicants have the burden of showing” (emphasis added).

Applicants respectfully remind the Examiner that Applicants are entitled to a patent unless the claimed invention is anticipated or rendered obvious by prior art (35 U.S.C. §§ 102, 103). Therefore, the burden of non-patentability lies with the USPTO. In the instant case, as admitted in the Office Action, the applied reference fails to disclose each and every feature recited in the claims and therefore, the claims are not anticipated by Pasqualoni. The burden lies with the USPTO to show the claimed features are disclosed or suggested in a prior art reference and not with the Applicants to disprove an element not disclosed or suggested in a reference.

Further, as it is admitted that Pasqualoni does not disclose the claimed feature, it appears that the Examiner is attempting to shift the burden to Applicants by asserting an *inherency* argument (i.e., “it is apparent that the size distribution of the reference reads directly on the size distribution of the claimed invention absent evidence to the contrary, which applicants have the burden of showing”). However, under the principles of inherency, the disclosure being relied upon must show that the natural result flowing from the operation of the device would result in the performance being claimed. *Hansgird v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939). Thus, inherency requires that those things will always flow naturally from that which is disclosed in a prior art reference. *Application of Smyth*, 480 F.2d 1376, 1384, 178 USPQ 279, 285 (CCPA 1973).

In the present case it is merely alleged that the reference anticipates or renders the subject matter of the rejected claims obvious because it is “apparent” that the “number of particles will display a size distribution.” Even accepting *arguendo* that a size distribution will occur, there is nothing in the reference, nor is there any further evidence provided, to indicate that the alleged size distribution will occur. Thus, a proper showing of inherency has not been established and the burden has not shifted to Applicants to disprove the Examiner’s allegation.

Moreover, as discussed above, it is alleged that the range disclosed in Pasqualoni (particle count having a diameter of greater than 0.5 μm is 25-150,000/30 μl) encompasses the claimed range of particles having a diameter greater than 1 μm at 6000 particles or more/ml. However, in order to anticipate the claims, the claimed subject matter must be disclosed in the reference with “sufficient specificity to constitute anticipation under the statute.” If the reference teaches a broad range...it

may be reasonable to conclude the narrower claimed range is not disclosed with sufficient specificity to constitute anticipation of the claims (MPEP §2131.03(II)).

In the instant case, as admitted in the Office Action, there is no disclosure in Pasqualoni "of the number of particles in the 1 micron size range." Thus, there is not sufficient specificity in Pasqualoni to anticipate the claimed range of particles in the 1 micron size range.

It is further alleged in the Office Action that it would have been obvious to select the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be *prima facie* obvious. However, as there is not overlapping range disclosed in Pasqualoni of the number of particles having a diameter of 1 μm or more, there is no overlapping range. Therefore, it cannot have been obvious to select such an overlapping range.

Regarding claims 6 and 14-16, Pasqualoni fails to disclose or suggest a semiconductor polishing composition...wherein a pH of the alkali aqueous solution is in a range of 12 to 14. Rather, the pH disclosed in Pasqualoni is at most 10.5.

It is also alleged in the Office Action that claims 6 and 14-16 are product-by-process claims. However, as there are no process limitations recited in these claims, the claims should not be examined as such.

As a *prima facie* case of anticipation or obviousness has not been established, withdrawal of the rejection is respectfully requested.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the rejections and allowance of the pending claims in connection with the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Fitzpatrick, 41,018 at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By: _____

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